

Serial No. 09/728,748

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Serial no.: | 09/728,748 |
| Filing date: | 12/02/2000 |
| For: | Veronica Plant named 'Glory' |
| Inventor: | Philpott |
| Atty. Docket no.: | PH17 |
| Group Art Unit: | 1661 |
| Examiner: | Para |
| Confirmation No.: | 2377 |

APPEAL BRIEF

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1. Real Party in interest

The real party in interest in the present appeal brief is Heather Philpott.

2. Related Appeals and Interferences

There are no related appeals or interferences.

3. Status of Claims

Claim 1 is pending. Claim 1 was finally rejected under 35 U.S.C. 102(b) as being unpatentable over Plant Breeders Rights publication number 971485 in the European Community published on February 16, 1998 in view of sales in Europe in May of 1998. The final rejection of claim 1 is being appealed.

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4. Status of Amendments

There are no amendments that have not been entered.

5. Summary of Claimed Subject Matter

The invention is a Veronica plant named 'Glory'. The invention is exemplified in claim 1, which recites a new and distinct variety of Veronica plant named 'Glory' as described and illustrated.

Support for this is found in the specification on pages 1-5 and in the photographs on sheets 1-3.

6. Grounds of Rejection to be Reviewed Upon Appeal

Issue 1 - Whether claim 1 is patentable under 35 USC 102 in view of Plant Breeders Rights publication number 971485 in the European Community published on February 16, 1998 in view of sales in Europe in May of 1998.

7. Argument

Issue 1 - Whether claim 1 is patentable under 35 USC 102 in view of Plant Breeders Rights publication number 971485 in the European Community published on February 16, 1998 in view of sales in Europe in May of 1998.

A. Veronica 'Glory' has never been sold to the public

As stated in the affidavit of Michael Dunnett, Blakedown Nurseries purchased 100 plants of Veronica 'Glory' in May of 1998. These 100 plants that were purchased from the inventor were never sold or publicly distributed. The plants were used for testing and propagation to build an inventory of plants.

As stated in the attached affidavit of Michael Dunnett, a market test was performed in April of 1999. Approximately 20 plants were sold under the name of 'Royal Candles'. No plants were sold under the name of 'Glory'. No advertising took place.

The public would not have had knowledge of sales of Veronica 'Glory' as the sale took place under the name 'Royal Candles'.

Because all sales during the market test took place under the name 'Royal Candles', one of skill in the art, with knowledge of the referenced publication, would not have found plants of 'Glory' to purchase, as plants labeled 'Glory' were never sold to the public.

The federal circuit court stated in In re Elsner, 381 F.3d 1125, 72 USPQ2d 1038 (Fed. Cir. 2004), that:

“the foreign sale must not be an obscure solitary occurrence that would go unnoticed by those skilled in the art.”

The sale of 100 plants of Veronica ‘Glory’ in May of 1998 to Blakedown Nurseries would have been unknown to those skilled in the art. These 100 plants were never sold and the sale was not publicized.

The sale of 20 plants of Veronica ‘Royal Candles’ during the market test in April of 1999 would also have been unknown to those skilled in the art looking for plants of Veronica ‘Glory’. No advertising or publicity took place.

The foreign sales of Veronica ‘Glory’ and Veronica ‘Royal Candles’ that occurred are an obscure solitary occurrence that would go unnoticed by those skilled in the art.

The holding in Elsner requires that the knowledge of the foreign sale must not be an obscure occurrence that would go unnoticed by those skilled in the art. The knowledge of the foreign sale must be public information just as a printed publication must be publicly available.

The foreign sales of Veronica ‘Glory’ and Veronica ‘Royal Candles’ that occurred were never publicized and the public would not have knowledge of their occurrence.

The foreign sales of Veronica ‘Glory’ and Veronica ‘Royal Candles’ that occurred were an obscure solitary occurrence that would go unnoticed by those skilled in the art.

B. One skilled in the art could not replicate Veronica 'Glory' more than one year prior to the filing date of the present invention

Plants of Veronica 'Royal Candles' commenced public sale in the spring of 2000 in Europe. A plant breeder would not have been able to purchase plants of 'Royal Candles' until that time.

The spring of 2000 is less than 1 year from the filing date of the present application.

A plant breeder would not have been able to purchase plants and successfully reproduce plants of the present invention more than 1 year prior to the filing date of the present application.

The sales during the market test and in the Spring of 2000 occurred under the name 'Royal Candles'.

One skilled in the art who is interested in reproducing Veronica 'Glory' would not know to go to Europe and purchase plants under the different name of 'Royal Candles' in order to replicate the plant.

A plant breeder wanting to replicate 'Glory' would logically go out and try to purchase plants of 'Glory'. The plant breeder would not find plants for sale under the name of 'Glory' and therefore would not have any plants to replicate. The sale of 'Royal Candles' in the United Kingdom does not enable the invention of 'Glory'.

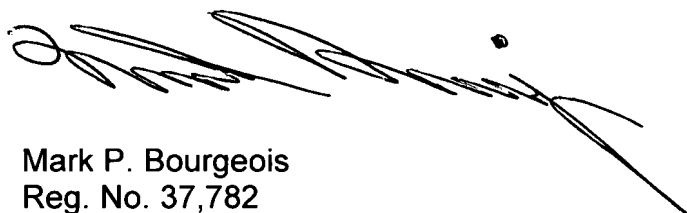
The knowledge or use relied on in a section 102 rejection must be knowledge that is available in the United States or use in the United States. Prior knowledge or

use which is not present in the United States, even if widespread in a foreign country, cannot be the basis of a rejection under section 102, *In re Ekenstam*, 256 F.2d 321, 118 USPQ 349 (CCPA 1958). There is no evidence to support that it was known in the United States that either Veronica 'Glory' or 'Royal Candles' were offered for sale, sold or planned to be sold in Europe more than 1 year prior to the filing date of the present application

The office has not established that a plant breeder would have knowledge in the United States to purchase plants of 'Royal Candles' in order to reproduce 'Glory'. There is no evidence to support the assertion that a plant breeder would know to purchase a plant under a different name in order to reproduce Veronica 'Glory'.

For the foregoing reasons, the Applicant asserts that the cited Plant Breeder's Rights publication is not a bar to patentability of the claimed new variety under 35 U.S.C. 102(b). For the extensive reasons advanced above, Appellant respectfully contends that the claim is patentable. Accordingly, reversal of all rejections is courteously solicited.

Respectfully submitted,



Mark P. Bourgeois
Reg. No. 37,782

Serial No. 09/728,748



8. Claims Appendix

The claims involved in the appeal follow below:

1. A new and distinct variety of Veronica plant named 'Glory' as described and illustrated.

9. Evidence Appendix

A. Affidavit of Michael Dunnett dated June 26, 2006

This affidavit was submitted with the Request for Continued Examination (RCE) dated July 3, 2006. This affidavit was acknowledged as being entered into the record by the examiner on page 2 of the office action dated December 19, 2006.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Heather Philpott
Serial number: 09/728,748
Filed: 12/02/2000
Title: Veronica Plant Named Glory
Attorney docket number: PH17

Group Number: 1661
Examiner: Annette Para

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AFFIDAVIT OF MICHAEL.L. DUNNETT

I Michael.L. Dunnett, hereby declare as follows:

I was the Managing Director of Blakedown Nurseries from June of 1974 until Blakedown Nurseries entered administration and discontinued operations in October of 1999. Blakedown Nurseries is located in the United Kingdom. Blakedown Nurseries was a wholesale nursery that only sold to other retail nurseries and garden centers. Blakedown Nurseries did not sell plants to the general public.

I was approached in the spring of 1997 by Heather Philpott, a gardener, who had discovered Veronica 'Glory'. It appeared that the variety might have commercial potential.

Blakedown Nurseries entered into a contract with Heather & Mike Philpott in January of 1998. This contract appointed Blakedown Nurseries as the exclusive producer and distributor of Veronica 'Glory', subject to successful propagation testing and growing trials by Blakedown Nurseries. No other parties were allowed to reproduce or sell Veronica 'Glory'.

In order to perform the propagation testing and growing trials and to start to build up quantities of Veronica 'Glory' sufficient for commercial sales, Blakedown Nurseries purchased

(15)

Michael L. Dunnett

approximately 100 plants of Veronica 'Glory' from Heather Philpott in May of 1998. These 100 plants were never sold or distributed to the public and remained in the possession of Blakedown Nurseries at all times. They were used for mother stock from which cuttings for propagation were taken.

There were problems that occurred during the propagation testing. The propagation of Veronica 'Glory' by vegetative cuttings encountered poor yields. It was unclear as to whether the poor yields had been caused by a failure to use the most appropriate rooting compound, by disease or if the cuttings had not been taken at the best time of the year.

In April of 1999, a market test of Veronica 'Glory' was performed. The plants were test marketed under the trade name 'Royal Candles'. One of the purposes of the test marketing was to establish the suitability of the name 'Royal Candles'. 38 plants of Veronica 'Glory' were provided to Cheals Garden Center in West Sussex, United Kingdom. These 38 plants were placed on sale for approximately a 2 week period. Approximately 20 of these plants were sold. The 18 unsold plants were returned to Blakedown Nurseries. The market test was not publicized and no advertising took place.

The summer of 1999 was used to perform additional propagation testing and to build up a further stock of plants in view of the losses that had occurred during previous propagation attempts.

Blakedown Nurseries entered administration in October of 1999 and all plants at the nursery were impounded by the administrators until an agreement was brokered with Notcutts Nurseries in December 1999 for the purchase of the plant inventory of the nursery.


The sale of plants of Veronica 'Glory' to the general public commenced in the spring of 2000, from Notcutts Nurseries in the United Kingdom under the trade name of 'Royal Candles'.

In re patent of: Heather Philpott
Serial number: 09/728,748
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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further; that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of any patent to which this verified statement is directed.

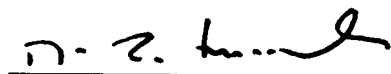
In Witness Whereof, we have hereunto set our hands and affixed our seals the

26th day of JUNE 2006.



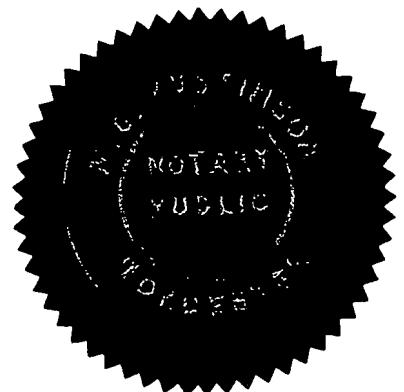
Michael Dunnett

On this 26th day of JUNE, 2006, before me personally appeared Michael Dunnett, to me known to be the person described in and who executed the foregoing instrument and acknowledged that they executed the same as their free act and deed.



Notary Public

M. G. HUSKINSON
NOTARY PUBLIC
WORCESTER
U.K.

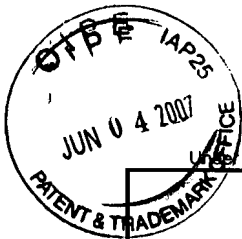


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10. Related Proceedings Appendix

There are no related proceedings.



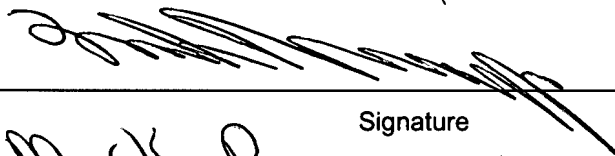
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